

in the outstanding Office Action. It is believed that the foregoing amendments add no new matter to the present application.

### **Specification Objections**

The Specification has been objected to for informalities. Applicant submits that the specification has been amended, as suggested by the Office Action, such that it overcomes the informalities enumerated in the Office Action. In view of the amendments, Applicant requests that the objection to the specification be withdrawn. Applicant submits that the amendments do not add new matter to the application.

### **Drawing Objection**

The Office Action Summary, PTO-326, indicates that the drawing figures are objected to by the Examiner. In a telephone conversation between the Examiner and Applicant's attorney, the Examiner indicated that the drawing objection was due to an alleged ambiguity between a reference to "processor 302" in the detailed description of the invention on page 8, line 11, and the reference number for "the process 402" in the figures. Applicant submits that the specification has been amended herein to correct the alleged ambiguity. Therefore, Applicant respectfully requests that the objection to the drawings be withdrawn.

### **Response to §103 Rejections**

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, *e.g.*, *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, "(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Furthermore, the Federal Circuit

has stated that “(i)t is impermissible, however, to simply engage in hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (1991).

### **Claim 1**

Claim 1 presently stands rejected under 35 U.S.C. §103 as purportedly being unpatentable over *Mori* in view of *Housel*. Amended Claim 1 presently reads as follows:

1. A method for printing information comprising:  
storing information corresponding to a print task in memory in a print-ready format, such that information in the print-ready format can be printed by a printing device without being processed by a driver; and  
***enabling a selected portion of the information in the print-ready format to be printed without printing a non-selected portion of the information in the print-ready format.*** (Emphasis added).

Applicant respectfully asserts that the cited art is inadequate to render pending claim 1 obvious. In particular, the cited art fails to suggest or teach at least the features of pending claim 1 highlighted hereinabove.

The Office Action states that “*Mori* does not specifically teach [a] printing system configured to enable the selected portion of the print task to be printed without printing a non-selected portion of the print task.” See Office Action, page 4. However, the Office Action asserts that *Housel* does teach a printing system exhibiting this feature, and Applicant respectfully traverses this assertion.

In this regard, *Housel* appears to generally teach a printing system that permits a user to select portions of a print task to be printed on selected mediums. However, it does not appear that the print task is “information in print-ready format.” To the contrary, *Housel*

specifically teaches allowing a user to select print task pages and associated mediums at the printer interface, and thereafter, the “central processing unit 17 converts the information ...into printer-readable language for the printer.” See *Housel*, paragraph 52, lines 5-10.

Therefore, it does not appear that the alleged combination teaches or suggests “enabling a selected portion of the *information in the print-ready format* to be printed without printing a non-selected portion of the information in the print-ready format,” as claimed in claim 1. (Emphasis added). Accordingly, Applicant submits that the Office Action fails to overcome its burden of establishing that each of the combination of features highlighted hereinabove for claim 1 is suggested or taught by the cited art.

For at least the foregoing reasons, Applicant submits that the 35 U.S.C. §103 rejection of claim 1 is improper and should be withdrawn.

#### **No Motivation to Combine**

In addition, in rejecting pending claim 1, it is asserted in the Office Action that:

“[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of *Mori* to permit the user to print only a selected portion of a print task since *Housel et al.* Teaches that this structure enables the users to easily designate their desired print jobs when inputting their request commands at the printer.”

However, Applicant respectfully asserts this alleged motivation for combining *Mori* with *Housel* is inadequate.

In this regard, the Office Action fails to cite a specific teaching in the cited art showing that the alleged motivation for combining *Mori* with *Housel* is suggested by the cited art. “There must be some reason, suggestion, or motivation *in the prior art* whereby a person of ordinary skill in the field of the invention would make the combination.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992)(emphasis added).

Moreover, Applicant submits that the aforementioned reason proffered in the Office Action

for combining *Mori* with *Housel* is not gleaned from the cited art but is instead based on improper hindsight reconstruction of Applicant's invention. As a result, the combination of *Mori* and *Housel* to reject pending claim 1 under 35 U.S.C. §103 is improper.

### **Claims 2-9 and 21-23**

Claims 2-9 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Mori* in view of *Housel*. Further, claims 21-23 have been newly added via the amendments set forth herein. Applicant submits that the pending dependent claims 2-9 and 21-23 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-9 and 21-23 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Claim 10**

Claim 10 presently stands rejected under 35 U.S.C. §103 as purportedly being unpatentable over *Mori* in view of *Housel*. Amended claim 10 presently reads as follows:

10. A print system comprising:  
a job retention system configured to store print-ready information corresponding to a print task and to receive an input corresponding to a selected portion of the print-ready information, the print-ready information being configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device, ***the job retention system being further configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.*** (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that the cited art fails to suggest or teach at least the features of claim 10

highlighted hereinabove. Therefore, the 35 U.S.C. §103 rejection of claim 10 is improper and should be withdrawn.

### **Claims 12-20**

Claims 12-20 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Mori* in view of *Housel*. Further, claim 22 has been added via the amendments set forth herein. Applicant submits that the pending dependent claims 12-20 and 22 contain all features of their respective independent claim 10. Since claim 10 should be allowed, as argued hereinabove, pending dependent claims 12-20 and 22 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER &  
RISLEY, L.L.P.**

By: [see paper #4]  
Paul Qualey  
Reg. No.  
(770) 933-9500 Ext. 277

Intellectual Property Administration

P.O. Box 272400  
Fort Collins, Colorado 80527-2400



**ANNOTATED VERSION OF THE  
AMENDED CLAIMS**

The following is a mark-up version of selected claims indicating amendments,  
wherein brackets are used to indicate deletions and underlines are used to indicate insertions.

1. A method for printing information comprising:  
storing information corresponding to a print task in memory in a print-ready format,  
**[the information in the print-ready format being configured for use by a printing device**  
**]such that [the ]information in the print-ready format can be printed by [the]a printing device**  
without being processed by a driver**[ of the printing device];** and  
enabling a selected portion of the **[print task ]information in the print-ready format** to  
be printed without printing a non-selected portion of the **[print task]information in the print-**  
**ready format**.

2. The method of claim 1, further comprising:  
providing a printing device; and  
printing the selected portion of the **[print task ]information in the print-ready format**  
using the printing device.

4. The method of claim 1, further comprising:  
receiving an input corresponding to a user's intent to print only a portion of the **[print**  
**task]information in the print-ready format**; and  
enabling only the selected portion of the **[print task ]information in the print-ready**  
**format** to be printed.

5. The method of claim 4, further comprising:

receiving an input corresponding to a user's intent to print the entire **[print task]**information in the print-ready format; and

enabling the entire **[print task ]**information in the print-ready format to be printed.

6. The method of claim 4, further comprising:

enabling the user to select at least the portion of the **[print task ]**information in the print-ready format to be printed.

7. The method of claim 6, wherein the printing device has a user interface; and

wherein enabling the user to select at least the portion of the **[print task ]**information in the print-ready format comprises:

enabling the user to select at least the portion of the **[print task ]**information in the print-ready format via the user interface.

9. The method of claim 6, further comprising:

providing a driver, the driver being configured to receive information and configure the information in the print-ready format, the driver being further configured to provide a graphical user interface; and

wherein enabling the user to select at least the portion of the **[print task ]**information in the print-ready format comprises:

enabling the user to select at least the portion of the **[print task ]**information in the print-ready format via the graphical user interface.

10. A print system comprising:



a job retention system configured to store print-ready information corresponding to a print task and to receive an input corresponding to a selected portion of [a print task ]the print-ready information, [and retrieve information corresponding to the selected portion of the print task, ]the print-ready information being [in a print-ready format ]configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device, the job retention system being further configured to enable the selected portion of the [print task ]print-ready information to be printed without printing a non-selected portion of the [print task ]print-ready information.

11. The print system of claim 10, further comprising:  
a printing device having a memory, the print-ready information [corresponding to the print task ] being stored in the memory of the printing device; and  
wherein the job retention system resides in the printing device.

12. The print system of claim 10, wherein the printing device includes a user interface, the user interface being configured to enable a user to select at least the portion of the [print task ]print-ready information.

14. The print system of claim 11, further comprising:  
a workstation communicatively coupled to the printing device, the workstation having a driver, the driver being configured to [configure information in the print-ready format and provide]convert information into the print-ready [format ]information and provide the print-ready information to the printing device, the driver being further configured to provide a

graphical user interface, the graphical user interface being configured to enable the user to select at least the portion of the **[print task ]**print-ready information.

15. The print system of claim 10, further comprising:

a workstation having a driver configured to provide a graphical user interface, the graphical user interface being configured to enable a user to select at least the portion of the **[print task ]**print-ready information.



**ANNOTATED VERSION OF SELECTED PARAGRAPHS  
OF THE SPECIFICATION**

The following is a mark-up version of selected paragraphs of the specification indicating amendments, wherein brackets are used to indicate deletions and underlines are used to indicate insertions.

*Please substitute the following for the paragraph on page 7 at line 1-9:*

Generally, in terms of hardware architecture, computer 400 of FIG. [3]4 includes a processor 402, memory 404, and one or more input and/or output (I/O) devices 406 (or peripherals) that are communicatively coupled via a local interface 408. Local interface 408 can be, for example, one or more buses or other wired or wireless connections, as is known in the art. Local interface 408 can include additional elements, which are omitted for ease of description. These additional elements can be controllers, buffers (caches), drivers, repeaters, and/or receivers, for example. Further, the local interface may include address, control, and/or data connections to enable appropriate communications among the components of computer 400.

*Please substitute the following paragraph on page 8, line 8-12.*

When the computer 400 is in operation, processor 402 is configured to execute software stored within the memory 404, communicate data to and from the memory 404, and generally control operations of the computer 400. Job retention system 100 and the O/S 410, in whole or in part, are read by the processor [3]402, perhaps buffered within processor 402, and then executed.

*Please substitute the following paragraph on page 11, line 8-21.*

RECEIVED  
MAR 11 2003  
TECHNOLOGY CENTER 2800

Another embodiment of print system 10 is depicted schematically in FIG. 6. In FIG. 6, print system 10 includes a job retention system 100, the functionality of which is implemented via a driver-side system 100A and a printing device-side system 100B. Each of the driver-side system 100A and printing device-side system 100B can be implemented in hardware, firmware, software or a combination thereof. In particular, when implemented as software, the driver-side system 100A and printing device-side system 100B each can be associated with a computer or processor-based device, e.g., devices 600A and 600B, respectively, each of which may be similar to that described in relation to computer 400 of FIG. 4. For ease of description, such a device will not be described in detail again. However, it should be noted that driver-side system 100A typically is associated with a user workstation or other network device that is able to communicate information corresponding to a print task, and printing device-side system 100B typically is associated with a printing device. As shown in FIG. 6, these devices communicate via network 1[6]50.

*Please substitute the following paragraph at page 8, line 13-23.*

When job retention system 100 is implemented in software, it should be noted that the remote print system can be stored on any computer readable medium for use by or in connection with any computer-related system or method. In the context of this document, a computer-readable medium is an electronic, magnetic, optical, or other physical device or means that can contain or store a computer program for use by or in connection with a computer-related system or method. [Secure tunnel]Job retention system 100 can be embodied in any computer-readable medium for use by or in connection with an instruction execution system, apparatus, or device, such as a computer-based system, processor-containing system, or other system that can fetch the instructions from the instruction execution system, apparatus, or device and execute the instructions.

BEST AVAILABLE COPY